

RECEIVED  
CENTRAL FAX CENTER

DEC 01 2005

Serial No.: 09/752152  
Attorney Docket No: 120-235

**CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the  
United States Patent and Trademark Office at number 571-273-8300  
12/1/2005

\_\_\_\_\_  
date

  
\_\_\_\_\_  
Signature

Carol Ann Mahoney

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Transmittal x 2	2 pages
Notice of Appeal x 2	2 pages
Request for Oral Hearing x 2	2 pages
Pre Appeal Brief	4 <del>7</del> pages

Total pages ~~12~~ 11

**BEST AVAILABLE COPY**

**RECEIVED  
CENTRAL FAX CENTER**

**DEC 01 2005**

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  <small>(to be used for all correspondence after initial filing)</small>	Application Number	09752152
	Filing Date	Dec 29, 2000
	First Named Inventor	Jackson
	Art Unit	2661
	Examiner Name	Phunkuth
Total Number of Pages in This Submission	Attorney Docket Number	120-235

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance communication to (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Notice of Appeal <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request for Oral Hearing Pre Appeal Brief Request for Review
Remarks: <u>Please charge any fee deficiency or credit any overpayment to Deposit Account 502569</u>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm Name	Steubing McGuinness & Manaras LLP
Signature	<i>Mary Steubing</i>
Printed name	Mary Steubing
Date	Reg. No. 37946

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Signature	<i>C. Mahoney</i>
Typed or printed name	C. Mahoney
Date	12/1/05

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DONOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**BEST AVAILABLE COPY**

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  <small>(to be used for all correspondence after initial filing)</small>	Application Number	09/752152
	Filing Date	Dec 29, 2000
	First Named Inventor	Jackson
	Art Unit	2661
	Examiner Name	Phunkuth
Total Number of Pages in This Submission	Attorney Docket Number	120-235

**RECEIVED**  
**CENTRAL FAX CENTER**

**DEC 01 2005**

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance communication to (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Notice of Appeal <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request for Oral Hearing Pre Appeal Brief Request for Review
Remarks: _____ Please charge any fee deficiency or credit any overpayment to Deposit Account 502569		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Steubing McGuinness & Manaras LLP		
Signature	<i>Mary Steubing</i>		
Printed name	Mary Steubing		
Date		Reg. No.	37946

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature	<i>C Mahoney</i>		
Typed or printed name	C Mahoney	Date	12/1/05

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DONOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**BEST AVAILABLE COPY**

RECEIVED  
CENTRAL FAX CENTER

DEC 01 2005

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jackson

Application No.: 09/752,152

Filed: 12/29/2000

Title: Local Area Network with Electrochemical  
Power Source

Group Art Unit: 2661

Examiner: Phunkulh

Attorney Docket No.: 120-235

Nortel: 13360RN

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

Dear Sir:

The Applicant hereby requests a Pre-Appeal Brief review of the above identified patent application. The Applicant files this Request for a Pre-Appeal Brief review so that the panel of Examiners may determine whether the Office Actions of record adequately establish that: (1) Claims 1 - 4, 6 - 20, 22 - 35, and 37 - 47 are *prima facie* obvious under 35 U.S.C. 103 over Cole et al. (US 6,348,874), ("Cole"), in view of Lehr et al. (US 6,643,566), ("Lehr"); and (2) dependent claims 5, 21, and 36 are *prima facie* obvious under 35 U.S.C. 103 over Cole in view of Hutchison et al (US 5,838,989), ("Hutchison"). The Applicant submits that the Examiner has failed to carry his burden of establishing a *prima facie* case of obviousness, as shown below:

## I. Claims 1 - 4, 6 - 20, 22 - 35, and 37 - 47

1. The Examiner has failed to provide a combination of references that teach or suggest a central network device including an electrochemical power source wherein the electrochemical power source is configured to provide backup power to the at least one selected member network device in the event of an interruption of delivery of primary power to the central network device.

BEST AVAILABLE COPY

Serial No. 09/752152  
2661

- 2 -

Art Unit:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Applicant respectfully submits that the combination of Cole and Lehr fails to teach or suggest the Applicant's claimed central network device including an electrochemical power source wherein the electrochemical power source is configured to provide backup power to the at least one selected member network device in the event of an interruption of delivery of primary power to the central network device.

Cole, as the Office Action admits, fails to teach or suggest a central network device including an electrochemical power source. (Office Action of Sept. 1, 2005, p. 3 1<sup>st</sup> paragraph). Furthermore, Cole provides no suggestion that an electrochemical power source should reside in a central network device, nor does Cole suggest that the central network device include an electrochemical power source for use as a backup device (Applicant's response of October 28, 2005, p.11, last paragraph).

Likewise, Lehr also fails to teach or suggest a central network device including an electrochemical power source. Lehr shows, in one embodiment, the use of an external UPS in a conventional manner, as an external general purpose power supply. Lehr teaches that UPS's may be placed in "strategic locations" in the network (Lehr, Co. 9 lines 5 - 22). The Office Action suggests that "it would have been obvious ...to supply the teaching of Lehr especially backup battery power supply or UPS in the system taught by Cole for maintaining a communication network in event of power failure i.e. electric failure". However, the resultant combination still fails to teach or suggest the Applicant's claimed invention. Both Cole and Lehr fail to teach or suggest a central network device including an electrochemical power source. Therefore, there is no way to combine Cole and Lehr that would suddenly suggest this innovative arrangement. The combination of Cole and Lehr therefore fail to teach or suggest the Applicant's claimed central network device including an electrochemical power source wherein the electrochemical power source is configured to provide backup power to the at least one selected member network device in the event of an interruption of delivery of primary power to the central network device.

**BEST AVAILABLE COPY**

Serial No. 09/752152  
2661

- 3 -

Art Unit:

2. The Examiner has failed to provide any motivation for combining the references in any way that would teach or suggest a central network device including an electrochemical power source wherein the electrochemical power source is configured to provide backup power to the at least one selected member network device in the event of an interruption of delivery of primary power to the central network device.

It is well established that, in order to support a rejection under 35 U.S.C. §103, sufficient motivation for combining the references must be shown by the Examiner. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 568 (CCPA 1972).

The Applicant has asserted that it is unlikely that one skilled in the art would be motivated to combine Cole with Lehr to arrive at the Applicant's claimed invention. Cole teaches only that a network communication device (12) is coupled to an external power source Vs, which may be an AC or DC supply (Cole Col. 3 lines 1 – 5). Lehr teaches that external power can be supplied by a UPS (Lehr Fig. 2A). If one skilled in the art were to apply Lehr to Cole, one would plug the conventional UPS of Lehr into the power port of the communications device of Cole. Nothing contained in Cole, Lehr, or otherwise provides any motivation to build a communications device including an electrochemical power source and a network interface. Such suggestion can only be provided in hindsight in light of the Applicant's specification, and this is clearly erroneous.

**BEST AVAILABLE COPY**

Serial No. 09/752152  
2661

- 4 -

Art Unit:

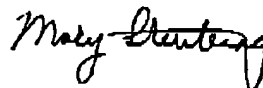
For these reasons, the Applicant asserts that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 1 - 4, 6 - 20, 22 - 35, and 37 - 47. The rejection is therefore erroneous and should be withdrawn.

## II. Claims 5, 21, 36

Dependent claims 5, 21, and 36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Hutchison et al (US 5,838,989), hereinafter Hutchison. The Applicant asserts that this rejection is erroneous. In order to establish a prima facie case of obviousness, the prior art references when combined must teach or suggest all the claim limitations. However, Cole and Hutchison, taken either alone or in combination, fail to do so.

As previously established in Argument I. above, Cole fails to teach or suggest the applicant's claimed communications device including an electrochemical power source. Hutchison fails to provide any further suggestion of use of an electrochemical power source by a central network device for delivering backup power to other network devices. Since Cole and Hutchison, taken either alone or in combination, fail to teach or suggest the Applicant's claimed invention, this rejection is erroneous and should be withdrawn.

Respectfully Submitted,



12/1/05  
Date

Mary Steubing, Reg. No. 37,946  
Attorney/Agent for Applicant(s)  
Steubing McGuinness & Manaras LLP  
125 Nagog Park Drive  
Acton, MA 01720  
(978) 264-6664

Docket No. 120-235

**BEST AVAILABLE COPY**